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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,497	05/19/2004	Hajime Mizutani	U 015200-1	6008
140	7590	07/12/2007	EXAMINER	
LADAS & PARRY			SPEER, TIMOTHY M	
26 WEST 61ST STREET				
NEW YORK, NY 10023				
			ART UNIT	PAPER NUMBER
			1775	
			MAIL DATE	DELIVERY MODE
			07/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/849,497

Applicant(s)

MIZUTANI ET AL.

Examiner

Timothy M. Speer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5, 10-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 10-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 10-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamikubo (US 2003/0138599).

3. Regarding independent claim 1, Kamikubo teaches image-protecting films having a protective layer releasably laminated on a support to be heat transferred onto an image of recorded matter, wherein the surface of the support on which the protective layer is laminated has a surface roughness,  $R_a$ , of not less than 0.100 (abstract and paragraph [0032], for instance). Thus, Kamikubo teaches that surface roughness is a result effective variable and, moreover suggests optimizing this variable to be greater than 0.1. Kamikubo does not teach that the surface roughness is 0.2 to 0.5, as presently claimed. However, it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In the present case, Kamikubo teaches that the surface roughness should be greater than 0.100. Accordingly, to discover optimum or workable ranges with respect to surface roughness would have been obvious to one having ordinary skill in the art, since Kamikubo teaches that surface roughness is a result effective variable and, moreover, suggests that the surface roughness should be greater than 0.100.

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4. Kamikubo teaches that the support may be formed of polyesters, such as polyethylene terephthalate and include inorganic fillers, the same as those disclosed in the subject specification (paragraphs [0031] and [0032]). Kamikubo further teaches that the support may be roughened by spraying with inorganic particles (paragraph [0032]) and protective layer may comprise a protective layer and an adhesive layer laminated from the support side (figure 2 and accompanying text). Regarding the protective layer, Kamikubo teaches that it may be formed of mixtures of thermoplastic resins (paragraph [0048]). Accordingly, to select appropriate resins based on the disclosure lies within the level of ordinary skill in the art and is considered to be prima facie obvious; this merely requiring the discovery of optimum or workable materials. Kamikubo further teaches that the protective layer may include waxes and finely divided silica, as recited in the present claims. Discovering optimum or workable amounts of such materials, as recited in claims 11 and 15 is considered to be prima facie obvious.
5. Regarding claims 17 and 18, Kamikubo further teaches that the articles disclosed therein may be used in image protecting methods, such as those claimed.
6. In light of the above, it is the Examiner's position that the present claims are prima facie obvious in view of the applied prior art.

#### ***Response to Arguments***

7. Applicant's arguments filed 04/13/07 have been fully considered but they are not persuasive. In response to the rejection over Kamikubo, applicant argues that the present claims achieve unexpected results compared to the disclosed prior art. This argument is not persuasive.
8. Applicant relies on certain data contained in the subject specification to demonstrate that the claimed invention produces unexpected results. These data, however, are not commensurate

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in scope with the claimed invention and, accordingly, are not considered to be persuasive.

Specifically, with respect to surface roughness, the present claims recite a range of 0.2 to 0.5, but the examples in Table 1 were only carried out at values of 0.3 and 0.4. Similarly, the present claims require a Tg of from -50 to 60, yet the examples in Table 1 all have a Tg of -22.

Accordingly, the proffered evidence is not commensurate in scope with the claimed invention and, therefore, not persuasive. Kamikubo suggests each and every limitation recited in the present claims and, as discussed above, to select from that disclosed in the prior art is considered to be prima facie obvious.

9. In light of the above, applicant's arguments have been considered, but are not found to be persuasive.

#### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

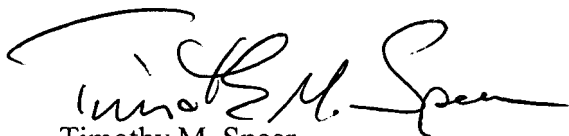
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385.


The examiner can normally be reached on M-Th, M-F.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Timothy M. Speer



JENNIFER C. MCNEIL  
SUPERVISORY PATENT EXAMINER  
7/9/7